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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,482	12/12/2003	Georg Neumann	021756-003500US	2477

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EXAMINER

ROCHE, TRENTON J

ART UNIT	PAPER NUMBER
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2193

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/735,482

Applicant(s)

NEUMANN ET AL.

Examiner

Trenton J. Roché

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003 and 12 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to communications filed 12 December 2003.
2. Claims 1-50 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected for reciting the limitation "analyzing the object to evaluate the component's compliance with the Americans with Disabilities Act." However, the Examiner finds the use of such language in a claim inherently indefinite, as the ADA, originally signed into law in 1990, is susceptible to legislative amendments and as such, the context of what is ADA compliant can change over time. Furthermore, there is no reference in the claims as to how the components necessarily comply with the requirements of the ADA or what would necessarily meet the compliance requirement. Accordingly, reference to the act in general is indefinite, and furthermore, the scope of the claim cannot be reasonably ascertained as the claims do not define what would necessarily be compliant with ADA requirements.
5. Claims 47-50 are rejected for failing to cure the deficiency of the independent claim from which they depend.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 44, 46 and 48-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. The invention as disclosed in claims 44, 46 and 48-50 is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." (State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373, 47 USPQ2d at 1601-02.)

9. Claim 44 is directed to a data structured that can be used to test a software program. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *In re Warmerdarn*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

10. Claim 46 is directed to a method of determining a software program's compliance, however, the claim does impart any functional or tangible **final result** of said determination. Consequently, the claims are non-functional descriptive material which merely represent an abstract idea or concept, and do not impart a certain level of "real world" value or practical application for the

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claimed invention. Where the result is what has been determined, calculated, selected, decided, etc. without using what has been determined, calculated, selected, decided, etc. in a disclosed practical application or at least making what has been determined, calculated, selected, decided, etc. available for use through some form of conveyance, the Office position is that a tangible result has not been achieved which enables any usefulness of having done the step to be realized.

11. Claims 48-50 are rejected for failing to cure the deficiency of the independent claim from which they depend.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-18, 20-34 and 36-45 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,475,843 to Halviatti et al. ("Halviatti").

Per claims 1, 20-22, 24, 28-31, 38, 39, 44 and 45:

Halviatti discloses:

- determining a cursor position ("determine if the mouse cursor is entering the active window..." in col. 13 line 32)
- ascertaining an accessibility context associated with the cursor position, identifying a component by reference to the accessibility context ("that button may be registered with the Message Engine...Events associated with that button...are then trapped for processing...a

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link is established to an individual resource or control...the system traps various events which are relevant to the established links..." in col. 10 lines 55-67. The Examiner interprets "accessibility context" to be the association between the object and the registration with its resource or control.)

- searching a component hierarchy for an object having an accessibility context matching the component's accessibility context ("EventInfo class hierarchy..." in col. 12 lines 63-64.

Further, "examines the EventInfo object and attempts to match it with a registered window link." in col. 17 lines 37-39)

- replaying an event by calling a program method defined by an accessibility role for the object ("a sequence of events can be recorded...for later replay." in col. 18 lines 38-40)

substantially as claimed.

Per claims 2-4 and 36:

Halviatti further discloses a set of properties as claimed (Note col. 19 lines 10-11).

Per claims 5, 6, 8-11 and 40-42:

Halviatti further discloses a trigger as claimed (Note col. 18 lines 7-14. Further, note col. 6 lines 20-33, which discloses the various window events, and note Appendix A.)

Per claims 7, 12 and 43:

Note the rejection regarding claim 1. Replaying a sequence of events would require executing a second time. Further, the display device is used to view the event.

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Per claims 13-18 and 37:

Note the rejection regarding claim 1. Further, the script record can be modified to change the established link. Note col. 9 lines 46-65.

Per claim 23:

Note col. 6 lines 20-33.

Per claim 25:

Halviatti further discloses actions consisting of selecting and deselecting a component as claimed (“whether the checkbox instance is ‘checked’ or ‘unchecked’...” in col. 34 lines 1-2.)

Per claims 26 and 27:

Halviatti discloses text components and performing actions on text components as claimed (“displaying and manipulating screen objects, such as...text object...” in col. 6 lines 15-16.

Per claim 32:

Halviatti further discloses writing a result of the event to a file (“logged in the log file.” in col. 37 line 20).

Per claims 33 and 34:

Halviatti further discloses evaluating the result of the events as claimed (“results generated may be observed for error.” in col. 22 lines 34-35).

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Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 19, 35 and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halviatti.

Per claim 19:

Halviatti does not explicitly disclose writing the record to an XML file. Official Notice is taken that at the time the invention was made, XML was a well established standard and that it would have been obvious to one of ordinary skill in the art to utilize an XML file for recording purposes, as this would enable easy processing, parsing, and sharing of information concerning the system.

Per claims 35, 46, 47, 49 and 50:

Note the rejection regarding claim 1. Halviatti does not explicitly disclose the Americans with Disabilities Act, however, Official Notice is taken that at the time the invention was made, ADA and Section 508 requirements were fully in place for employer software systems, and accordingly, it would have been obvious to one of ordinary skill in the art to check compliance of a software system with federal laws such as ADA to ensure compliance.

Per claim 48:

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Note the rejection regarding claim 2.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trenton J. Roche whose telephone number is (571) 272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Trenton J Roche
Examiner
Art Unit 2193

TJR


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